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EXAMINER

SAMS, MATTHEW C

ART UNIT PAPER NUMBER

2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/634,143	Applicant(s) MIRALLES ET AL.	
	Examiner Matthew C. Sams	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 3-20 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action has been changed in response to the amendment filed on 10/30/2006:
2. Claim 20 is no long under the status of (New) but should be (Previously Presented).

Response to Arguments

3. Applicant's arguments filed 10/30/2006 have been fully considered but they are not persuasive.
4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "true bi-directionality whereby the any given message need not originate solely from a mobile phone, but instead may originate elsewhere, such as in a server" [Page 6 last para]) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In contrast, claim 19 explicitly recites "the communication being originated in either the mobile telephone user (7) or the remote server (1)". Further, Smith states "an SMSC receives a short message from **any source** intended to be delivered to a particular subscriber" (Col. 1 lines 66-67) and shows in Fig. 1 that the SMSC is connected to the Internet, which is made up of standard computers running e-mail

clients. It is the examiner's opinion that this scenario anticipates a short message originating or being sent to a remote server.

5. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Smith and Martschitsch are both related to the same field of endeavor, transmitting/receiving SMS messages and converting SMS messages into different formats. Further, motivation can be found by enabling secure SMS messaging through hash values (Martschitsch Col. 6 lines 20-33), enabling messages longer than 160 characters for the convenience of the user (Martschitsch Col. 5 lines 18-30) and the automatic conversion of characters that can not be sent in SMS messages to legible characters for the user's convenience. (Martschitsch Col. 5 4-17)

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "this coding cannot be used for the **sending of longer messages**" Claims 5-6 Page 8) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 12, 14 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US-6,891,811 hereinafter, Smith)

Regarding claim 19, Smith teaches a system of interconnecting a remote server with a short message service centre (SMSC) through the Internet (Col. 1 lines 8-12), which is providing the means for sending and receiving (Col. 1 lines 45-49) short messages (SMS) between a remote server (Fig. 1 [152, 154 & 156]) and a mobile telephone user (Fig. 1 [120]) which is in bi-directional communication with a SMSC (Fig. 1 [124]) on a GSM network (Col. 1 lines 31-49 & Col. 6 lines 6-11), existing bi-directional transmission/reception of messages between the remote server and the mobile telephone user, the communication being originated in either the mobile telephone user or the remote server in an independent way (Col. 6 lines 48-54, Fig. 4 & Fig. 7), with the remote server (Fig. 1 [152, 154 & 156]) being provided with means for communicating with the SMSC (Fig. 1 [124]) via HTTP (Fig. 1 and Col. 6 lines 1-37), for which both the SMSC and the remote server are provided with means of bi-directional transmission/reception of short messages via the HTTP protocol (Fig. 1 [100] & Col. 6 line 1 through Col. 7 line 41), characterized in that the transmission & reception of the SMSC and the remote server comprises a client module for the composition and

transmission of messages ("electronic mail" Col. 1 lines 61-67 & "e-mail" Col. 2 lines 18-32), and a server module for the reception of messages, server modules comprising an SMS-HTTP message reception block and a data analysis block with is provided with access to a database provided with means for verifying the data of originator, addressee of the message and access code, and as a function of this verification is also provided with means for generating a return code signaling data correct or data error. (Fig. 4 and Col. 6 line 1 through Col. 7 line 41) Smith differs from the claimed invention by not explicitly reciting the client module comprises an SMS-HTTP message composition block which is provided with means for composing short messages adapted for transmission via the HTTP protocol.

However, Smith teaches a mobile to HTTP gateway being a "black box" which is installed into existing systems to enable bi-directional communication between a mobile device and one or more IP servers. (Col. 5 lines 12-18) It would have been obvious to one of ordinary skill in the art to integrate the "black box" mobile to HTTP gateway into the IP server since it allows the Wireless Internet Gateway to communicate directly with the IP servers which reduces the lag time. (Fig. 3) The client module then would comprise an SMS-HTTP message composition block which is provided with means for composing short messages adapted for their transmission via the HTTP protocol (Col. 6 lines 13-36), in which SMS messages convert into http messages directly, also being provided with a block for transmission of SMS-HTTP messages to server modules to which it is intended to send them, by integrating the mobile to HTTP gateway into the IP server. (Fig. 3 [100 & 152])

Regarding claim 3, Smith teaches a conversion feature for converting SMS-HTTP messages to SMS messages. (Col. 9 lines 50-55)

Regarding claim 12, Smith teaches that mandatory and optional parameters of the short messages are sent. (Smith Col. 8 lines 50-56)

Regarding claim 14, Smith teaches the server and client modules have a means for generating acknowledgement receipts for all messages received. (Smith Col. 7 lines 50-52 and Appendix A)

Regarding claim 16, Smith teaches the means of reattempting transmission of failed messages a certain number of times have been foreseen and of reattempting transmission of acknowledgement of receipt messages a certain number of times. (Smith Appendix A [5.4])

Regarding claim 17, Smith teaches the SMS is sent from a remote server to the mobile telephone user and/or from the mobile telephone user to the remote server. (Fig. 1, 3, 4 and Col. 6 line 1 through Col. 7 line 41)

Regarding claim 18, Smith teaches the client module and server module of the operator of the mobile telephony network has the means of simultaneous communication with a plurality of remote servers to furnish simultaneous connection to a mobile telephone user with a plurality of remote servers. (Fig. 1)

Regarding claim 20, the limitations of claim 20 are rejected as being the same reason set forth above in claim 16.

9. Claims 4-11, 13 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Martschitsch (US-7,020,479).

Regarding claim 4, Smith teaches the limitations of claim 19 above, but differs from the claimed invention by not explicitly reciting the use of HASH security functions.

In an analogous art, Martschitsch teaches a method and system for preparing and transmitting SMS messages in a mobile radio network that includes using HASH security functions for verifying a message's integrity. (Col. 6 lines 20-33) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the SMS conversions of Smith after modifying it to incorporate HASH security functions of Martschitsch. One of ordinary skill in the art would have been motivated to do this since it makes the network more secure.

Regarding claims 5 and 6, Smith in view of Martschitsch teaches the client and server modules have encoding and decoding means to allow more characters and symbols to be send/received. (Martschitsch Col. 4 lines 7-16 and Col. 5 lines 18-30)

Regarding claim 7, Smith in view of Martschitsch teaches the ability to transmit the SMS-HTTP message to GSM characters prior to composing the SMS message to send it along the GSM network. (Smith Fig. 1 and Col. 5 line 37 through Col. 6 line 67)

Regarding claim 8, Smith in view of Martschitsch teaches the ability to segment information in order to send longer messages. (Martschitsch Col. 5 lines 18-21)

Regarding claim 9, Smith in view of Martschitsch teaches the means of segmentation are foreseen in the message composition block. (Martschitsch Col. 5 lines 18-21)

Regarding claim 10, Smith in view of Martschitsch teaches the ability to segment information in order to send longer messages. (Martschitsch Col. 5 lines 18-21)

Regarding claim 11, Smith in view of Martschitsch teaches the means of segmentation are foreseen in the message composition block. (Martschitsch Col. 5 lines 18-21)

Regarding claim 13, Smith in view of Martschitsch teaches the short message composition block of the server module is provided with the means for recovery of the mandatory and optional parameters in the event they are omitted and a means for inserting default values. (Smith Col. 8 lines 27-30 e.g. `registered_delivery_flag`)

Regarding claim 15, Smith in view of Martschitsch teaches the server modules are provided with a return code transmission block that provides the means for indicating that the transmission has been correct or has been errored and a means to identify the type of error produced, the client devices also have return code reception blocks. (Smith Appendix A [5.4 & 7.1])

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Sams whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCS
1/17/2007


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